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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,175	06/26/2003	George Plester	25040-0925	7784
29052	7590	01/26/2005	EXAMINER	
SUTHERLAND ASBILL & BRENNAN LLP			BUEKER, RICHARD R	
999 PEACHTREE STREET, N.E.			ART UNIT	
ATLANTA, GA 30309			PAPER NUMBER	

1763

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/609,175

Applicant(s)

PLESTER ET AL.

Examiner

Richard Bueker

Art Unit

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 42-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-41, drawn to an apparatus, classified in class 118, subclass 723R.
- II. Claims 42-44, drawn to an apparatus, classified in class 53, subclass 266.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the dictionary definition of the word "as" includes "for instance", and "in a manner similar to", and therefore the phrase "a system for making a coated plastic container as in claim 1" which is used in claim 42 (with analogous language in claims 43 and 44) does not require all of the limitations of the apparatus of claim 1. Also, the phrase "as in claim 1" can be interpreted as referring to the plastic coating container produced by the apparatus of claim 1, rather than referring to the apparatus of claim 1 itself. The subcombination has separate utility such as with a filler for filling a plastic container with sand instead of a beverage, or for producing empty containers.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. King on January 18, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-41. Affirmation of this election must be made by applicant in replying to this Office action. Claims 42-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter of claims 23 and 34 is not in the specification. The specification does not describe an apparatus "wherein the first vacuum cell and the second vacuum cell are different regions of the same vacuum cell". It is noted that the specification at page 7, lines 7-12, describes an apparatus with "at least one polymer coating source disposed in the same or another vacuum cell". Also, at page 26, lines 25-28, the specification describes an apparatus wherein "the polymer coating sub-system 420 and the evaporator system are combined within a single

Art Unit: 1763

vacuum cell". The specification, however, doesn't state that when the polymer coating sub-system and evaporator system are in the same single cell, that each is also considered to be a cell. It is clear that applicants are using the word "cell" in a broad sense. The language of claims 23 and 34 should be included in the specification to provide proper antecedent basis for these claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 and 33-41 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Plester (WO 98/40531) (see Fig. 1). The apparatus of Plester includes "one or more gas feeds for supplying one or more process gases into an interior space of the vacuum cell" as recited in claim 1. See, for example, the gas feeds labeled 7 and 13 in Fig. 1 of Plester. Also, the claim 1 limitation of "wherein at least one of the process gases is a carbon-containing gas" is a recitation of intended use that Plester's apparatus is inherently capable of performing. Regarding claims 33-41, these claims recite a "melter-evaporator" disposed in a second cell. Claim 34, however, makes clear that the claimed "second cell" is intended to mean

"a different region" of the same cell in which the inorganic coating material evaporator is located. Also, Fig. 3 and the paragraph bridging pages 19 and 20 of applicants' specification describe the "melter-evaporator" in the same terms as for the inorganic material evaporator 106 of Fig. 1 (see also page 10, lines 23-25 of the specification). Evaporators 106 and 306 can both be crucibles that are heated by radiant heaters or resistance heaters of the type known in the prior art. Also, Plester teaches (Figs. 9A and 9B, page 14, lines 13-24 and page 21, lines 1-8, for example) the use of plural evaporators. He teaches the use of "more than one source 1" to deposit more than one type of substance, and he teaches that "more than one layer, each layer comprising a different composition, can also be beneficial". Plester teaches that his sources are inductively or resistively heated. Plester teaches that his sources are melters and evaporators (page 11, lines 19-26 and page 31, lines 34-36), and are therefore melter-evaporators. Plester's melter-evaporators have an inherent capability of being used to melt and evaporate a polymer material. It is noted that claims 20 and 33-41 refer to evaporation of polymers in terms of an intended use only, and they are not so limited. The apparatus comprising a melter-evaporator recited in claims 33-41 reads on the plural melter-evaporator apparatus disclosed by Plester.

Claims 20, 22-26 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plester (WO 98/40531) taken in view of Shaw (5,725,909) and Affinito (6,224,948). Shaw (abstract, col. 6 lines 47-65) teaches that it is desirable to coat a bottle with a acrylate polymer layer via a polymerizable acrylate gas process, prior to and/or subsequent to the deposition of an inorganic oxide vapor barrier coating

of the type disclosed by Plester. It would have been obvious to one skilled in the art to modify the apparatus of Plester to include means for producing an acrylate coating of the type taught by Shaw, because Shaw teaches that this results in improved results for an oxide coated bottle. Shaw, however, does not teach the use of a plasma means for forming the desired acrylate coating by plasma polymerization. Affinito, however, teaches that it was known in the art that acrylate coatings could be formed by providing a means for energizing a polymerizable acrylate gas. It would have been obvious to provide the desirable acrylate coatings taught by Shaw by means of a plasma polymerization process as taught by Affinito, because Affinito teaches that his process eliminates the need for a curing station.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plester (WO 98/40531) taken in view of Shaw (5,725,909) and Affinito (6,224,948) for the reasons stated in the previous paragraph rejection, and taken in further view of Bauer (6,455,442). Affinito (paragraph bridging cols. 5 and 6) teaches the use of a "ballast gas" in his plasma, which he defines as a gas providing sufficient molecules to keep the plasma lit, but he does not specifically list any of the inert gases recited in claim 29. Bauer (col. 15, lines 20-35), however, teaches that gases such as helium, argon or air can be used as plasma gases in an acrylate plasma polymerization process, and it would have been obvious to use any of these conventional plasma gases as a ballast gas in Affinito's process.

Claims 22, 23, 27, 28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plester taken in view of Darras (2002/0179603). Plester discloses an


apparatus for forming a "main coating" on the outside of a bottle, as recited in claim 1, but does not disclose further means for depositing a polymer coating in a second vacuum cell by plasma polymerization as also recited in claim 22. Darras, however, teaches as apparatus for forming such a plasma polymerized coating on the inside of a bottle. It would have been obvious to one skilled in the art to provide the bottle coating apparatus of Plester with an additional cell for coating the inside of a bottle as taught by Darras, as the combination would be merely additive and the results of such a combined system would be no more than expected.

Claims 22, 23, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plester taken in view of Felts (6,112,695). Plester discloses an apparatus for forming a "main coating" on the outside of a bottle, as recited in claim 1, but does not disclose further means for depositing a polymer coating in a second vacuum cell by plasma polymerization as also recited in claim 22. Felts, however, teaches as apparatus for forming such a plasma polymerized coating on the inside of a bottle. It would have been obvious to one skilled in the art to provide the bottle coating apparatus of Plester with an additional cell for coating the inside of a bottle as taught by Felts, as the combination would be merely additive and the results of such a combined system would be no more than expected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Bueker whose telephone number is (571) 272-1431. The examiner can normally be reached on 9 AM - 5:30 PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on (571) 272-1439. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Richard Bueker
Primary Examiner
Art Unit 1763